

REMARKS

I. Introduction

In response to the pending Office Action, Applicants have amended claim 1 to include the elements of claim 4, which has been cancelled. In addition, claim 18 was amended to address the objection thereto set forth in paragraph 5 of the Office Action. No new matter has been added.

As claim 4 was indicated to be allowable, it is respectfully submitted that claim 1, as amended herein, is in condition for allowance. In addition, although claim 6 was indicated to be rejected under 35 U.S.C. § 103, it is noted that claim 6 also recites the limitation that "the thickness of said coating is less than the particle diameter of said conductive filler", which as set forth in the Office Action (see, paragraph 13 of the Office Action), is the basis for allowance of claim 1. This limitation was added to claim 6 in an amendment filed on July 19, 2002. Accordingly, it is respectfully submitted that claim 6 is patentable over the cited prior art for at least the same reason as claim 1. Indeed, it is expected that the foregoing limitation of claim 6 was inadvertently overlooked as it is not mentioned in the pending rejection. Thus, it is submitted that claim 6 and the claims dependent thereon are also in condition for allowance. Applicants also acknowledge the indication of allowance of claim 18 upon correction of the pending objection for lack of proper antecedent basis for all claim elements.

Accordingly, of the four independent claims currently pending, which are claims 1, 6, 9 and 18, only claim 9 remains rejected in view of prior art references. Applicants respectfully submit that claim 9 is patentable over the cited prior art for the reasons set forth below.

II. The Rejection Of The Claim 9 Under 35 U.S.C. § 103

Claim 9 was rejected under 35 U.S.C. § 103 as being obvious over USP No. 6,262,785 to Ikeda, in view of USP Publication No. 2001/0026017 to Seto. For the following reasons, it is respectfully submitted that claim 9 is patentable over the cited prior art.

Claim 9 recites that the coating of a **conductive adhesive** disposed on the external electrode contains a conductive filler, and more importantly, that the coating is disposed on the **entire surface** of the external electrode (as shown, for example, in Figs. 1 and 2 of the present invention). As a result of the structure of the claimed device, it is possible minimize alignment problems/issues when mounting the device to, for example, a circuit board. More specifically, because **the conductive adhesive is applied to the entire surface of the external electrode**, the orientation of the device when it is placed in contact with the connecting terminals disposed on, for example, the circuit board becomes irrelevant. For example, regardless of the rotational position of the device, as each side of the electrode has the conductive adhesive disposed thereon, as long as the device makes contact with the connecting terminals, the device can be properly secured to the connecting terminals.

In contrast, in Ikeda, the conductive adhesive 11 is only applied to a bottom surface of the electrode 5. As such, the orientation of the device 1 of Ikeda is clearly relevant when positioning the device onto a substrate. For example, referring to Fig. 1 of Ikeda, if the device 1 was turned upside-down, the device could not be secured to the substrate 7 as the conductive adhesive would no longer be in contact with the pad

9. Accordingly, significantly greater care must be taken with devices such as disclosed by Ikeda in order for the devices to be properly mounted on the substrate. Such care is both costly and time consuming. Thus, the present invention provides a significant benefit over the device of Ikeda.

Turning to Seto, this reference is neither relied upon, nor does it cure the foregoing deficiencies of Ikeda. Accordingly, at a minimum, the combination of Ikeda and Sato fail to disclose or suggest the claimed device in which ***the conductive adhesive is applied to the entire surface of the external electrode.***

As is well known, each and every limitation of the claimed invention must be disclosed or suggested by the prior art in order to establish a *prima facie* case of obviousness (see, M.P.E.P. § 2143.03). As the combination of Ikeda and Seto fail to do so, it is submitted that claim 9 is patentable over Ikeda and Seto taken alone or in combination with one another.

Further, it is also well known that the fact that the prior art could be modified so as to result in the combination defined by the claims at bar would not have made the modification obvious unless the prior art suggests the desirability of the modification. ***In re Deminski***, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

Indeed, recognizing after the fact that such a modification would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. ***In re Warner***, 379 F.2d 1011, 154, USPQ 173 (CCPA 1967).

It is only Applicants' disclosure that discloses a device in which ***the conductive***

adhesive is applied to the entire surface of the external electrode. Neither Ikeda nor Seto appear to describe or suggest such a feature. Thus, the only motivation of record for the proposed modification of the device of Ikeda or Seto to arrive at the claimed invention is found in Applicants' disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103.

Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987).

III. All Dependent Claims Are Allowable Because The Independent Claims From Which They Depend Are Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, ***Hartness International Inc. v. Simplimatic Engineering Co.***, 819 F.2d at 1100, 1108 (Fed. Cir. 1987).

Accordingly, as claims 1, 6, 9 and 18 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

IV. Request For Notice Of Allowance

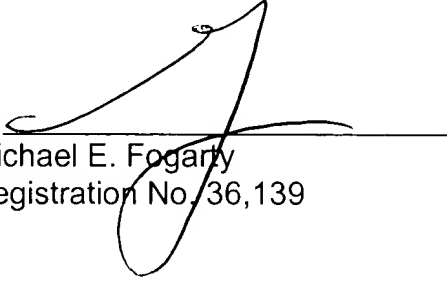
Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

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